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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,292	03/27/2001	Daniel F. Williams	PSTM0042/MRK	1726

29524 7590 04/05/2007  
KHORSANDI PATENT LAW GROUP, A.L.C.  
140 S. LAKE., SUITE 312  
PASADENA, CA 91101-4710

EXAMINER
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PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/820,292

Applicant(s)

WILLIAMS ET AL.

Examiner

Jamisue A. Plucinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-169 is/are pending in the application.
- 4a) Of the above claim(s) 22-26, 28-61, 66-99, 104-137 and 142-169 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 27, 62-65, 100-103 and 138-141 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/07 has been entered.

### ***Election/Restrictions***

2. Newly amended claims 22, 23-26, 39-59, 77-99, and 115-137 are directed to an invention that is independent or distinct from the invention originally claimed and elected in the restriction of 3/25/05 for the following reasons: The examiner on 3/25/05 made a nine-way restriction requirement, in which the applicant elected Invention I. The applicant has amended the claims to take the different independent claims of Invention I in multiple directions. One direction is an indication of a shipment and a list of items which has at least one item as being indicated as returnable. Applicant takes other claims in the direction of issuing a return credit when the merchant receives a return. The later limitation has not been previously presented in the claims. At the time of the restriction the examiner would have required a restriction on this set of claims being directed to this limitation, therefore due to the fact that the limitation of an indication of a shipment and a list of items which has at least one item as being indicated as returnable, as been presented before, and the applicant has already received an office action on the merits of these claims.

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Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-26, 39-59, 77-99 and 115-137 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-10, 19-21, 60-65, and 100-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab et al. (US 2002/0019777) in view of Siegel (US 2004/01435519).

5. With respect to Claims 1-9, 60-65, and 100-102: Schwab discloses the use of an online merchandise return computer system (see abstract, the examiner considers the online

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merchandise return computer system to include both the merchant computer, as well as the third party/agent computer, due to the fact that they both computers cooperatively work together, to process and return a product) where the computer system is programmed to:

- a. Receive an indication of shipment of an item and a indication that the item is returnable (see ReturnCert, and Paragraph 0052-0053).
  - b. Save a set of return rules which is inputted by a merchant (Paragraphs 0052 and 0053) where the rules provides exceptions where a user cannot return item (Paragraph 0071)
  - c. Receive an online return request by a consumer (Paragraph 0052);
  - d. Process return request according to the set of return rules (Paragraph 0053).
  - e. Schwab discloses the use of a set or return questions (Parameter request, reference numeral 605, product return parameters, such as description of product and condition of product), and processing the return according to the rules (See Paragraphs 0012, and Paragraph 0053).
6. Schwab, however, fails to disclose the use of a display, which displays each item of a previous order and an interactive means associated with each item in each order, to return an item. Siegel discloses a return system where a user's previous orders along with each item in the order are displayed, and each item is associated with a checkbox, which the examiner considers to be an interactive means, to submit a return request (See Figure 1A with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab to include the display and interactive means of Siegel, in

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order to provide a single action return process to reduce the amount of sensitive information transmitted to increase security and ease of use for the customer (See Siegel, Pages 1 and 2).

7. With respect to Claims 19 and 20: Schwab and Kara, as disclosed above, fails to disclose the use of generating a return shipping label and printing the shipping label. Siegel discloses the use of an online merchandise return system, which prints shipping labels for returns (See abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Schwab and Kara, to include the function of providing shipping labels for the return, in order to simplify processing for both the shipping agent and the user. (See Siegel, Page 5)

8. With respect to Claim 21: See Siegel, Figure 1A, and Figure 5 with corresponding detailed descriptions

9. Claims 10-12, 27, 62-65, 103, and 138-141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab et al. and Siegel and further in view of Kara (6,233,568).

10. With respect to Claims 10, 11, 24, 25, 62-64 and 138-141: Schwab, as disclosed above for Claims 1, 39, 11 and 115, disclose the use of shipping the return to the manufacturer, but fails to disclose selecting a carrier for shipment and calculating the shipping rate for the return. Kara discloses the use of a system used to select a carrier for shipment and calculating shipping rates for a plurality of carriers (See Figure 8, with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers,

according to Kara, in order to for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract).

11. With respect to Claims 12, 27, 65, and 103: See Kara Figure 8.

12. Claims 13-21, 27, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab, Siegel and Kara as applied to claim 11 above, and further in view of UPS® Service Guide ([www.ups.com](http://www.ups.com)) and FedEx® Services ([www.fedex.com](http://www.fedex.com)) and Barnett et al. (6,369,840).

13. With respect to Claims 13-16, 27, and 65: Schwab and Kara discloses an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services (See Kara, Figure 8). However Kara does not specifically disclose the rates being calculated with respect to time. Both UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive “urgency” services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services, where one axis being date and one axis being time and where each cell is located at the intersection of the date and time. Barnet discloses the use of a calendar which can be sued for online purchasing of services (column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the calculation of shipping rates, calculated by Kara,

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UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

14. With respect to Claim 17: See Schwab, return transaction 619.

15. With respect to Claim 18: See Kara, Figure 9.

***Response to Arguments***

16. Applicant's arguments filed 1/12/07 have been fully considered but they are not persuasive.

17. With respect to Applicant's arguments in terms of the subject matter of claim 1 of a display of returnable items: this is a new limitation added to the claim, and the rejection has been modified above to cover this new limitation.

18. With respect to the subject matter of claim 22 (and Claims 39, 60, 77, 98, 115 and 136) to credit a user's credit card: These claims have been withdrawn from consideration and therefore argument is considered moot.

19. With respect to Applicant's arguments and the subject matter of Claim 24: These claims have been withdrawn from consideration and therefore argument is considered moot.

20. With respect to Applicant's argument with regards to the subject matter of Claim 100: This is a new limitation, which has been added, and the rejection above has been modified accordingly. As stated above, Schwabb discloses when the returns can not be accepted, therefore consider this to be exceptions.

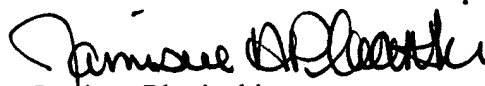
21. Rejections stand as stated above.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jamisue Plucinski  
Patent Examiner  
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